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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,721	10/16/2003	Charles Morris	10238-022	4622
27383	7590	12/31/2007		
CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131			EXAMINER WINTER, JOHN M	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 12/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,721

Applicant(s)

MORRIS ET AL.

Examiner

John M. Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,10-12,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,10-12,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4,6-8,10-12 and 17-18 are drawn towards a secure transaction, classified in class 705 subclass 67.

II. Claims 13 and 14 are drawn to a system for secure transaction, classified in class 705 subclass 67.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the subcombination as claimed in inventions II such as a restricted item and a store attendant., Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper filed on September 26, 2007 a provisional election was made without traverse to prosecute the of Invention I, claims 1-4,6-8,10-12 and 17-18. Affirmation of this election

must be made by applicant in replying to this Office action. Claims 13 and 14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-8,10-12, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison et al (U.S. Patent No. 6,522,772) in view of Mason (U.S. Patent No. 6,408,279).

As per claim 1,

Morrison et al teaches

A self-checkout system comprising: a self-checkout station configured for customer-operated self-checkout of items for purchase; and a controller operatively coupled to the plurality of supervisory terminals and to the self-checkout station, said controller being configured to administer communications between checkout stations and supervisory terminals, and to send data over a network to a selected supervisory terminal instructing the mobile terminal to initiate a biometric data capture operation, said biometric data capture operation being related to a self-checkout transaction. (*fig 1, column 2 lines 44-3 line 18, 8 lines 46-60, and the entire*

disclosure).

Morrison et al fail to teach a plurality of supervisory data terminals, of which at least one is a mobile terminal comprising a wireless network interface and a biometric data sensor, configured to monitor and supervise self-checkout transactions. However, Mason teach a plurality of supervisor terminal of which a least one is a mobile terminal comprising a wireless network and a biometric sensor configure to monitor and supervise self-checkout transactions (*fig 1 column 4 lines 8-44*)). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Morrison et al to include Mason's plurality of supervisor terminal of which a least one is a mobile terminal comprising a wireless network and a biometric sensor configure to monitor and supervise self-checkout transactions because this would have enhance the flexibility of the system by allowing customer to purchase any item without the help of any cashier; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

The Examiner notes that the claimed invention is largely directed towards intended usage of a system, as denoted by such language as "a self-checkout station configured for customer-operated self-checkout of items for purchase", the Examiner states that the mere configuration of a system is not considered a postive claim limitation.

The Examiner further notes that the feature of "supervisory data terminals" is admitted in the Applicants specification as being well know in the art at the time of the invention (pages 2-3), therefore the Examiner concludes that the usage of a supervisory data terminal would be obvious to one of ordinary skill in the art at the time of the invention.

Claim 17 is in parallel with claim 1 and is rejected for at least the same reasons.

As per claim 2,

Morrison et al teaches the system of claim 1 wherein:

the self-checkout station is one of a plurality of self-checkout stations and the supervisory terminals are operatively coupled to the plurality of self-checkout stations; and the data sent to the a mobile supervisory terminal to initiate the biometric data capture comprises data identifying at least one self-checkout station for which biometric data capture is to be performed.*(see fig 1)*.

As per claim 3,

Morrison et al teach a system wherein the biometric sensor comprises a sensor selected from the group consisting of a fingerprint sensor, an iris recognition scanner, and a voice recognition device *(see column 7 line 10-57)*.

As per claim 4,

Morrison et al teach a system wherein the biometric data capture operation comprises receiving fingerprint attribute data at a fingerprint sensor *(see column 7 line 10-57)*.

As per claim 5,

Morrison et al teach a system wherein: the controller is a shared controller operatively coupled to each of the plurality of checkout stations; and the controller is configured to

administer biometric data capture for multiple ones of the plurality of self-checkout stations (*see fig 1*).

As per claim 6,

Morrison et al teach a system wherein the biometric data capture operation further comprises input of a date of birth (*fig 1, column 2 lines 44-3 line 18, 8 lines 46-60, and the entire disclosure*)

As per claim 7,

Morrison et al teach a system wherein the controller is configured to query a database using the date of birth as a key to retrieve a plurality of candidate age verification records, each record associating the date of birth with biometric attribute data characterizing a customer fingerprint previously captured at a fingerprint sensor (*see column 7 line 10-57*).

As per claim 8,

Morrison et al teach a system wherein: the controller is one of a plurality of controllers; each self-checkout station comprises a co-located one of the plurality of controllers; and each of the controllers is operatively coupled to the supervisory data terminal (*see fig 1*).

As per claim 9,

Morrison et al teach a system wherein: the mobile data terminal is one of a plurality of supervisory terminals; a first one of the supervisory terminals is operatively coupled to the

controller by a wireless data network; and a second one of the supervisory terminals is operatively coupled to the controller by a wired data network (*fig 1, column 2 lines 44-3 line 18, 8 lines 46-60, and the entire disclosure*).

As per claim 10,
Morrison et al teaches The system of claim 1, wherein at least one mobile supervisory data terminal is a battery operated mobile supervisory terminal (*see fig 1*).

As per claim 11,
Morrison et al teaches the system of claim 4, wherein:
the mobile supervisory data terminal and the controller interoperate to perform a plurality of supervisory functions associated with customer self-checkout at the checkout station; the supervisory functions comprise processing of a payment transaction. (*fig 1, column 2 lines 44-3 line 18, 8 lines 46-60, and the entire disclosure*).

As per claim 12,
Morrison et al teaches the system of claim 11, wherein:
the payment transaction comprises a payment type selected from the group consisting of a credit card payment, a debit card payment, and an electronic funds transfer payment; and processing the payment transaction further comprises receiving a signature input at the mobile supervisory data terminal.
(*fig 1, column 2 lines 44-3 line 18, 8 lines 46-60, and the entire disclosure*).

As per claim 18,

Morrison et al teach a method wherein the biometric sensor comprises a fingerprint sensor (*fig 1, column 2 lines 44-3 line 18, 8 lines 46-60, and the entire disclosure*).

Response to Arguments

The Applicants arguments filed on May 7, 2007 have been fully considered.

The Applicant states that to establish a case of obviousness, among other things, the Examiner must demonstrate that the prior art references include all the claimed limitations of the present invention; contrary to the Examiner's contention, Mason does not come close to teaching or suggesting any mobile terminal.

The Examiner responds the term "mobile" is merely a description of the type of terminal used by the Applicant, however there is no suggestion in the claimed invention that the feature of mobility lends itself to a patentably distinct process, In other words the Examiner contends that any arbitrary type of terminal (e.g. remote, hardware, software, virtual etc..) could be substituted for a "mobile" terminal without altering the claimed invention. Furthermore the Examiner contends that the usage of a "mobile" terminal as opposed to a "fixed" terminal" is merely a rearrangement of parts in a system and as such does not merit patentability.

The Examiner further notes that the claimed feature of "supervisory terminal" is discloses as admitted prior art by the applicants specification.

Conclusion

Application/Control Number:
10/687,721
Art Unit: 3621

Page 9

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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